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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,684	09/05/2003	Makarand P. Gore	200311300-1	6500

7590 06/02/2006

HEWLETT-PACKARD COMPANY
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EXAMINER

HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,684

Applicant(s)

GORE, MAKARAND P.

Examiner

Bruce H. Hess

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9-5-03 (IDS) and 2-18-05 (IDS)
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 10-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO-929/98)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____
- Paper No(s)/Mail Date 9-5-03 and 2-18-05

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The restriction/election requirement of the prior Office action is adhered to and made final for the reasons of record.

Claims 1-9 are rejected under 35 USC 112 (2) as being indefinite for the reasons set forth below;

A. If not admixed, what is the meaning of "in thermal contact" in the context of a composition claim ?; and

B. Since a composition does not have layers, the stabilizer cannot be "overprinted".

Claims 1-4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Morgan (USP 6,632,584: see column 8, lines 19, 20 and 43 and column9, lines 11, 12 and 53).

Claims 1-3 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Ramsden et al. (USP 6,514,677: see column 21, line 4; column 43, line33; and column 36, lines 8 and 9).

These patents both teach color forming compositions comprising a leuco dye, an infrared absorber (i.e., chroman) and a stabilizer (i.e., a croconium dye in Morgan). The experimental modification of this prior art inn order to ascertain optimum operating conditions (e.g., determine the infrared radiation wavelength), fails to render applicant's claims patentable in absence of unexpected results.



BRUCE H. HESS
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